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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,672	11/28/2001	Peter S. Weissman		8288

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Peter Weissman
2912 Upton St., N.W.
Washington, DC 20008

EXAMINER

TRAN, NGHI V

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,672

Applicant(s)

WEISSMAN, PETER S.

Examiner

Nghi V. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/28/01 06/20/02. 01/02/03, 02/24/03, 03/20/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Objections

1. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim is directly claimed as "the electronic mail message". However, the previous claim (i.e. claim 2) is directly claimed as "the computer program". Therefore, the claim is improper dependent form.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-20 are not limited to tangible embodiments. In view of Applicant's disclosure, paragraph 0004, the email is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. In response to Applicant's arguments that "the Examiner's rejection is incomplete since the Examiner does not cite any PTO guideline or case law that suggest that written software code is non-statutory subject matter".

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See MPEP 2106 page 2100-2012. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al., U.S. Patent Application Publication No. 2002/0099777 (hereinafter Gupta).

6. With respect to claims 1, 12, and 14, Gupta teaches a computer program [see abstract] comprising:

- a first email having a first message with at least one primary recipient [fig.4];
and,
- a second email having a second message with at least one secondary recipient, the second email separate from and associated with the first email and processed substantially simultaneously with the first email [figs.6-7].

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7. With respect to claims 2, 13, and 15, Gupta further teaches said second email is attached to said first email [fig.7].

8. With respect to claim 3, Gupta further teaches on the at least one secondary recipient(s) are the same as the at least one primary recipient(s) [fig.7].

9. With respect to claim 4, Gupta further teaches a plurality of primary recipients, wherein the at least one secondary recipient is one of the plurality of primary recipients [paragraphs 0061-0062 and 206 of fig.6].

10. With respect to claim 5, Gupta further teaches the first message and second message are created by a sender and substantially simultaneously transmitted by the computer program [fig.10].

11. With respect to claim 6, Gupta further teaches the first message and second message are substantially simultaneously received [i.e. collaborative electronic mail] by the computer program for one of the primary recipient and the secondary recipient [paragraphs 0008 and 0045-46].

12. With respect to claim 7, Gupta further teaches the first email and the second email are transmitted to each of the at least one primary recipient and the at least one secondary recipient as a single electronic mail [fig.7 and paragraph 0061].

13. With respect to claim 9, Gupta further teaches at least one of the at least one primary recipient receives the first message [fig.4], but not the second message [fig.6].

14. With respect to claim 10, Gupta further teaches said computer program comprises a mail service [see abstract].

15. With respect to claim 11, Gupta further teaches said first email has a first address field [180 i.e. to] identifying the at least on primary recipient and said second email has a second address field [182 i.e. cc] identifying the at least one secondary recipient [fig.4] [paragraph 0061-65].

16. With respect to claim 16-17 and 20, Gupta further teaches the processing the primary email comprises generating the primary email [fig.4] and said processing the second email comprises generating the secondary email [fig.2].

17. With respect to claim 18, Gupta further teaches the secondary window is sent to, but not display to, the primary recipient [fig.4].

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta as applied to claims 1 and 12 above, and further in view of Wagner et al., U.S. Patent No. 6,282,435 (hereinafter Wagner).

20. With respect to claims 8 and 19, Gupta is silent on a primary tab associated with the first message and a secondary tab associated with the second message, wherein the primary tab and secondary tab selectively display the first message and the second message, respectively.

In an electronic mail, Wagner discloses a primary tab [i.e. go] associated with the first message and a secondary tab [i.e. new] associated with the second message, wherein the primary tab and secondary tab selectively display the first message and the second message, respectively [fig.6].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Gupta in view of Wagner by adding a primary and secondary tap because this feature can be operated using an intuitive, easy-to-use interface. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Gupta in view of Wagner in order to allow users to switch from one to another tap easily.

Response to Arguments

21. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran
Patent Examiner
Art Unit 2151

NT


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER